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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,297	08/03/2005	Christopher James Lyddon	05-629	8152
20306 7590 10/16/2007 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			EXAMINER ADDIE, RAYMOND W	
			ART UNIT 3671	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/544,297	Applicant(s) LYDDON ET AL.	
	Examiner Raymond W. Addie	Art Unit 3671	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 RAYMOND ADDIE
 PRIMARY EXAMINER

Response to Arguments

1. Applicant's arguments filed 9/27/07 have been fully considered but they are not persuasive.

Applicant argues "Net 20 or 120 of Ousterhout et al. is not 'adapted to be laid flat on the ground' as the examiner alleges".

However, the Examiner does not concur.

Nothing in the actual claim language defines the scope of the "adaptation" which permits the net to be laid flat on the ground.

Further, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Applicant further argues "the net is not laid flat on the ground as claimed".

However, the Examiner does not concur.

Claim 1 explicitly recites "a net adapted to be laid flat on the ground in the path of a vehicle to be arrested". Clearly illustrated in Fig. 1, the net (20) can be laid flat on the ground in a stored position, and then raised above the ground to arrest a vehicle.

It should be quite clear from Applicant's claim language, the ability of the net to be "laid flat on the ground in the path of a vehicle to be arrested", is not a requirement for arresting the vehicle. Should such a limitation be intended by Applicant such should be more clearly set forth in the actual claim language.

Applicant then argues "the net is not...equipped with spikes for embedding in the vehicle's tires".

However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically, Horton et al. # 6,409,420 clearly teaches it is known in the art to provide vehicle capture nets with tire piercing spikes; in order to immobilize the vehicle being arrested. See Horton Cols. 3-4.

Applicant then argues Figures 20-23 of Ousterhout et al....do not show the net wrapping around the vehicle wheels...What these figures show is a single 'aft capture line (152)'. "

However, the Examiner does not concur. Clearly multiple capture lines (152) are illustrated wrapping around the wheels of the vehicle. Further the capture lines (152) are components of the net.

Further, it is quite obvious the addition of tire piercing spikes to the net, as taught by Horton et al., would in fact promote or otherwise cause the net to wrap around the wheels of vehicles with high ground clearance, such as cargo trucks.

Hence, it again must be put forth that:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is suggested the Applicant present the arguments in light of the actual claims being argued, such that the arguments can be considered in light of the actual limitations being claimed. In this case, it appears as though only dependent claim 17 requires a method step of "one or more said spikes become embedded in each said tire, the net becomes wrapped around the front wheels of the vehicle". To which the Examiner asserts the addition of tire piercing spikes on net of Ousterhout et al. would obviously cause the net to wrap around the wheels of the vehicle.

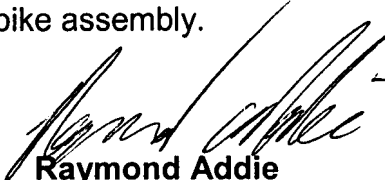
Applicant then argues "Ousterhout et al. further does not....disclose...the use of tire spikes mounted to the net...Neither do Horton et al. teach the claimed method of spike attachment as alleged".

However, the Examiner concurs in part. When the argument is considered in light of claim 9, which would be allowable if put in independent form; the examiner concurs. Thus, Applicant is again cordially invited to put claim 9 into independent form to further clarify the patentable distinction between Applicant's invention and that of the prior art.

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With respect to claim 26, the limitation that "said spike assemblies are attached to the net by penetrating the net with the spikes such that the material of the net encircles respective said shaft portions"; is quite obvious to the teachings of Horton et al.

Since, the actual limitation "by penetrating the net with the spikes such that the material of the net encircles respective said shaft portions", is a method step found in a apparatus claim. And thus, does not preclude the teachings of the prior art to Horton et al., because the teaching of Horton et al. provides for that material of the net to encircle respective shaft portions of the spike assembly.



Raymond Addie
Primary Examiner
Group 3600

10/11/07